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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DOUGLAS F. BEAVEN

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Appeal 2009-012140  
Application 09/312,740  
Technology Center 3600

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*Before* HUBERT C. LORIN, JOSEPH A. FISCHETTI, and  
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Douglas F. Beaven (Appellant) seeks our review under 35 U.S.C. § 134 (2010) of the final rejection of claims 191-211. We have jurisdiction under 35 U.S.C. § 6(b) (2010).

## SUMMARY OF DECISION

We REVERSE and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).<sup>1</sup>

## THE INVENTION

This invention is a program that allows management teams to “quickly plan, design, and work on a common portfolio of strategic goals and initiatives” and to “gain access to prepopulated external sources of knowledge, expertise and tools via the Internet.” Specification 11:22-12:3.

Claims 198 and 211, reproduced below, is illustrative of the subject matter on appeal.

198. A method of supporting management of a collaborative activity in a system which includes a processor, the processor having access to a database containing a model of the collaborative activity, the model including representations of model entities, a given representation of a model entity being capable of simultaneously belonging to hierarchy including a hierarchy, and another hierarchy, and that representations of model

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<sup>1</sup> Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Nov. 9, 2007) and Reply Brief (“Reply Br.,” filed Mar. 24, 2008), and the Examiner’s Answer (“Answer,” mailed Jan. 25, 2008).

entities providing access to information relating to the collaborative activity, the processor providing an interface for one or more users of the system who are not specialists in information technology, and the method comprising the steps performed in the system of:

- receiving a definition of a model entity belonging to the model of the collaborative activity from a user via the interface and responding thereto by producing a representation of the model entity in the database; and

- receiving a first indication of a first hierarchical relationship between the model entity and another model entity belonging to the hierarchy from the user via the interface and responding thereto by relating the model entity to the other model entity in the hierarchy and

- receiving a second indication of a second hierarchical relationship between the model entity and a third model entity belonging to the other hierarchy from the user via the interface and responding thereto by relating the model entity to the third model entity in the other hierarchy.

211. A system for supporting management of a collaborative activity by persons involved therein, the persons not being specialists in information technology and the system comprising:

- a representation of a model of the collaborative activity, the representation being accessible to a processor and the model of the collaborative activity including model entities, the model entities providing access to information concerning the collaborative activity, being organized into a plurality of hierarchies having a plurality of types" and a given model entity being capable of simultaneously belonging to a hierarchy

having one of the types and a hierarchy having another of the types; and  
a graphical user interface for the system which the processor provides to the persons, the graphical user interface permitting a person of the persons to perform operations on a model entity as limited by a type of access which the person has to the model entity, the operations including controlling access to the model entity, creating, modifying, and/or deleting the model entity, assigning the model entity to a location in a hierarchy, accessing and/or modifying the information concerning the collaborative activity via the model entity, viewing model entities as ordered by a hierarchy to which the entities belong, and viewing model entities as ordered by a value in the information concerning the collaborative activity to which the entities give access.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Buteau et al.	US 6,442,557	Aug. 27, 2002
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The Examiner took official notice that “both the concept and advantage of sending messages between people is well known and expected in the art.” Answer 8. [Hereinafter, Official Notice.]

The following rejections are before us for review:

1. Claims 191-194 and 197-211 are rejected under 35 U.S.C. §102(e) as being anticipated by Buteau.
2. Claims 195 and 196 are rejected under 35 U.S.C. §103(a) as being unpatentable over Buteau and Official Notice.

## ISSUES

The first issue is whether claims 191-194, 197, and 211 are anticipated under 35 U.S.C. § 102(e) by Buteau. Specifically, the issue is whether the Examiner erred in finding that Buteau describes a graphical user interface having a structure as required by claim 211. The rejection of claims 195 and 196 under 35 U.S.C. § 103(a) as unpatentable over Buteau and Official Notice also turns on this issue.

The second issue is whether claims 198-210 are anticipated under 35 U.S.C. § 102(e) by Buteau. Specifically, the issue is whether the Examiner erred in finding that Buteau describes a method which includes the steps of receiving a first indication of a first hierarchical relationship and a second indication of a second hierarchical relationship from a user via an interface as recited in claim 198.

## FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Buteau's Figure 8 is reproduced below.

Microsoft Access

File Edit View Insert Format Records Tools Window Help

Enter Organizations

Organization Name: Center for Applied Technology

Part ID: Defense Systems

Comments:

Enter Organizations

Location	Quantity	Comments
Los Angeles	2	
Malibu Hill	20	

Record 1 of 2

Form View

FIG. 8

2. Figure 8 depicts “a screen showing how attributes are entered into a database program.” Col. 3, ll. 49-50.
3. Buteau’s column 22, lines 20-31 states:

A screen depicting input of information into the database is illustrated in FIG. 8. The enterprise architect provides the possible attributes that may be entered into the database. The data architecture of the present invention enforces consistent description format among like entries and descriptions. For consistency, pull-down menus generated by extracting domains from other database entities are used to ensure that the consistent entries are made by different people. Without such a constraint, one person might enter a computer as a HP computer and another person might enter (or retrieve) the same technology item as a Hewlett-Packard computer.

## PRINCIPLES OF LAW

### *Anticipation*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

## ANALYSIS

*The rejection of claims 191-194 and 197-211 under §102(e) as being anticipated by Buteau*

### *Claims 191-194, 197, and 211*

Independent claim 211 is directed to an apparatus which includes a graphical user interface (GUI). Claim 211 requires that the GUI be structured such that it permits persons to perform operations on a model entity. The operations include:

controlling access to the model entity, creating, modifying, and/or deleting the model entity, assigning the model entity to a location in a hierarchy, accessing and/or modifying the information concerning the collaborative activity via the model entity, viewing model entities as ordered by a hierarchy to which the entities belong, and viewing model entities as ordered by a value in the information concerning the collaborative activity to which the entities give access.

Claim 211. In the rejection, the Examiner relies upon the GUI depicted in Figure 8 of Buteau, and the corresponding description in column 22, lines 20-31, to anticipate the claimed GUI. Answer 5-6; *see also* Answer 11-12.



The Appellant argues that Buteau's GUI in Figure 8 is not structured to be capable of performing these operations. App. Br. 7-8.

We see nothing in the GUI of Figure 8 of Buteau (FF 1) or the corresponding description in column 22, lines 20-21 which expressly or inherently describes that the GUI has a structure that is capable of permitting a person to perform the recited operations. For example, we see nothing in the cited figure or passage which expressly or inherently describes that the GUI has a structure for controlling access to a model entity or for deleting a model entity. Therefore, we find that the Examiner has erred in finding that Buteau's GUI in Figure 8 anticipates the claimed GUI.

Accordingly, we find that the Appellant has overcome the rejection of claim 211, and claims 191-194 and 197, dependent thereon, under 35 U.S.C. § 103(e) as being anticipated by Buteau.

#### *Claims 198-210*

Independent method claim 198 recites a step of "receiving a first indication of a hierarchical relationship between the model entity and another model entity belonging to the hierarchy from the user *via the interface*" and a step of "receiving a second indication of a second hierarchical relationship between the model entity and a third model entity belonging to the other hierarchy from the user *via the interface*." (Emphasis added.) In the rejection, the Examiner relies upon the same rationale used to reject claim 211, to reject claim 198. See Answer 9. The Appellant argues that Buteau does not describe that the GUI of Figure 8 can be used to perform these steps. App. Br. 12.

We see nothing in Figure 8 or the corresponding description in column 22, lines 20-21 that expressly or inherently describes receiving *via the interface* first and second indications of the specific hierarchical relationship as recited in claim 198. While the GUI may be used to edit the organization model entity, including data related to the organization hierarchy, as the Examiner argues (Answer 12), this does not describe the steps of receiving a first and second indication as specifically recited in claim 198. Therefore, we find that the Examiner has erred in finding that Buteau anticipates these steps.

Accordingly, we find that the Appellant has overcome the rejection of claim 198, and claims 199-210, dependent thereon, under 35 U.S.C. § 103(e) as being anticipated by Buteau.

*The rejection of claims 195 and 196 under §103(a) as being unpatentable over Buteau and Official Notice*

These rejections are directed to claims indirectly dependent on claim 211, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 195 and 196 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.") We note that the Examiner's taking of Official Notice does not cure the deficiencies of the Buteau reference discussed above.

### NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection. We reject claims 191-196 and 211 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Taking claim 211 as representative, claim 211 recites a system that includes a representation of a model and a graphical user interface. We note that the Specification describes the system that includes representation of a model and the graphical user interface as a software system. (*For example, see* Specification 11:20-24 and Specification 11:13-17). Giving claim 211 the broadest reasonable interpretation in light of the Specification, it would appear to encompass software per-se. Since a computer program per se<sup>2</sup> is not patent-eligible subject matter, claim 211 is directed to subject matter that is non-statutory under §101.

### DECISION

The decision of the Examiner to reject claims 191-211 is reversed. We enter a new ground of rejection on claims 191-196 and 211.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

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<sup>2</sup> See U.S. Patent & Trademark Office, Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101, Aug. 2009, at 2, available at [http://www.uspto.gov/patents/law/comments/2009-08-25\\_interim\\_101\\_instructions.pdf](http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf).

37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

REVERSED; 37 C.F.R. § 41.50(b)

JRG